UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,832	11/29/2001	Akiko Miyakawa	1642.1001	9732

21171 7590 07/19/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
SIMONE, CATHERINE A	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/995,832	MIYAKAWA ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,13 and 14* is/are pending in the application.

4a) Of the above claim(s) *4 and 8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-7,9,10,13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Withdrawn Rejections

2. The 35 U.S.C. 103 rejection of claims 1-3, 5-7 and 9-14 over Suzuki et al. of record in the Final Office Action mailed 4/1/04, Pages 2-4, Paragraph #2 has been withdrawn due to the Applicant's amendment filed 7/1/04.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-3, 5-7, 9, 10, 13** and **14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoki (4,883,548).

Regarding **claims 1, 2, 13** and **14**, Onoki discloses a resin-cemented optical element comprising a base member (Figs. 4-9, 3a-3f) and a resin layer (Figs. 4-9, 2a-2f) formed on a surface of the base member, wherein the base member has a molding surface that is convex (see col. 6, lines 39-42). However, Onoki fails to disclose the resin layer having a thickness of 300

μm or smaller at least at a part of a region with 1 mm from the peripheral edge face of the resin layer or at least at a part of a region outside an effective-diameter region, and the resin layer having a thickness of 850 μm or larger at a position which is thickest in that layer, and the resin layer having a diameter of at least 34 mm. Onoki does, however, teach the resin layer having a smaller thickness at a part of a region within 1mm from the peripheral edge face of the resin layer or at a part of a region outside an effective-diameter region and a larger thickness region (see Figs. 4-9, 2a-2f) and a diameter (see col. 3, lines 32-35 and col. 6, lines 21-23). Therefore, one of ordinary skill in the art would have determined the optimum ranges for the thicknesses and the diameter of the resin layer through routine experimentation depending on the desired end results as shown by Onoki. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the resin layer in Onoki to have a thickness of 300 μm or smaller at least at a part of a region with 1 mm from the peripheral edge face of the resin layer or at least at a part of a region outside an effective-diameter region, and to have a thickness of 850 μm or larger at a position which is thickest in that layer, and to have a diameter of at least 34 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding **claim 3**, note at least at a part of the region outside an effective-diameter region, the resin layer has a thickness which becomes gradually smaller toward a periphery (see Figs. 4-9, 2a-2f). Regarding **claims 5-7**, note an optical article comprising the resin-cemented optical element (see col. 1, lines 7-10). Regarding **claims 9** and **10**, note the resin layer is made by molding (see col. 3, lines 22-31).

5. **Claims 1-3, 5-7, 9, 10, 13** and **14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Onoki (JP 02-130519).

Regarding **claims 1, 2, 13** and **14**, Onoki discloses a resin-cemented optical element comprising a base member (Figs. 4-9, 3a-3f) and a resin layer (Figs. 4-9, 2a-2f) formed on a surface of the base member, wherein the base member has a molding surface that is convex (Figs. 4-9, 3a-3f). However, Onoki fails to disclose the resin layer having a thickness of 300 μm or smaller at least at a part of a region with 1 mm from the peripheral edge face of the resin layer or at least at a part of a region outside an effective-diameter region, and the resin layer having a thickness of 850 μm or larger at a position which is thickest in that layer, and the resin layer having a diameter of at least 34 mm. Onoki does, however, teach the resin layer having a smaller thickness at a part of a region within 1mm from the peripheral edge face of the resin layer or at a part of a region outside an effective-diameter region and a larger thickness region and a diameter (see Figs. 4-9, 2a-2f). Therefore, one of ordinary skill in the art would have determined the optimum ranges for the thicknesses and the diameter of the resin layer through routine experimentation depending on the desired end results as shown by Onoki. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the resin layer in Onoki to have a thickness of 300μm or smaller at least at a part of a region with 1 mm from the peripheral edge face of the resin layer or at least at a part of a region outside an effective-diameter region, and to have a thickness of 850 μm or larger at a position which is thickest in that layer, and to have a diameter of at least 34 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering

the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II).*

Regarding **claim 3**, note at least at a part of the region outside an effective-diameter region, the resin layer has a thickness which becomes gradually smaller toward a periphery (see Figs. 4-9, 2a-2f). Regarding **claims 5-7**, note an optical article comprising the resin-cemented optical element (see abstract). Regarding **claims 9** and **10**, note the resin layer is made by molding (see abstract).

Response to Arguments

6. Applicant's arguments with respect to claims 1-3, 5-7, 9, 10, 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Catherine Simone
Examiner
Art Unit 1772
July 14, 2004

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

7/14/04